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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HENDRICKS, KEITH D

ART UNIT

PAPER NUMBER

1761

8

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/929,066	Applicant(s) ITO ET AL.	
	Examiner Keith Hendricks	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 13 December 2002.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-5 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-5 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> .	6) <input type="checkbox"/> Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

New rejections:

Claims 1, 3 and 5 are indefinite for the recitation of the phrase “wherein said grain is a bean or soybean.” A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claims 1, 3 and 5 recite the broad recitation “bean”, and the claim also recites “soybean” which is the narrower statement of the range/limitation. These two terms overlap in scope, and there is no clear delineation as to what is included by the phrase. Note that claims 2 and 4 recite “wherein said grain is a bean”. This, however, encompasses both soybeans and all other types of beans, and thus it is unclear if the independent claims have been truly limited by claims 2 and 4. It is suggested that, as an acceptable example, claims 1, 3 and 5 be amended to recite “wherein said grain is a bean”, and claims 2 and 4 be amended to recite “wherein said bean is a soybean.”

Rejections maintained:

The claims remain indefinite as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The claims refer to “a composition comprising a superoxide scavenger”, which is “obtained from a specific liquid”. Again, the claims describe nothing about the superoxide scavenger itself, or even the composition which comprises said

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superoxide scavenger, which is the object of the invention. The claims describe nothing about how the "composition" is "obtained from" a "specific liquid". The claims only refer to the method of preparing the "specific liquid", in general terms at that. Thus, the claims are not even directed to a "product-by-process", as there is a discontinuity between the process steps, and how one skilled in the art is to arrive at the *claimed* composition of matter. ✓

Further, the phrase above, as well as the remainder of claims 1-5, do not provide a mode by which the composition is extracted from the "specific liquid", nor do they provide a structural corresponding relationship to the specific liquid, from which the composition is extracted. Also, the distinction between claims 1-4 and the "beverage containing a specific liquid prepared by" the *same steps* (claim 5), is unclear. ✓

Note that claim 3 is even further removed from the actual composition product, with respect to the issues stated above, in that it is directed to "a beverage" which contains "a composition comprising a superoxide scavenger", which is "obtained from a specific liquid." ✓

Finally, there does not appear to be any extraction step disclosed or described in the specification, such that the claimed invention would be supported by the current language of "obtained from." ✓

Applicant's arguments filed December 13, 2002, have been fully considered but they are not persuasive. At page 5 of the response, applicants state that "the amended claim recites a superoxide scavenger obtained from a specific liquid without any extraction step. Therefore the description of an extraction step is not needed." This is not deemed persuasive for the reasons of record, and those recited above. Applicants' statement does not address or nullify the points of the rejection as noted above. ✓

Claims 1-5 remain rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the removal of the grain or grain components from the grain liquor. See the last sentence of page 3, to the top of page 4 of the specification, as well as the example description at the top of page 5, where the "soybeans were removed to obtain an initial liquor". This step is an essential step to the claims, for it, at the least, clarifies that the remainder of the steps, and thus the product itself, do not contain the grain or solid grain components. ✓

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Claim Rejections - 35 USC § 102 & 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Qian (CN 1123833). The reference and rejection are taken as cited in a previous Office action.

Applicant's arguments filed December 13, 2002, have been fully considered but they are not persuasive. At page 7 of the response, applicants state that “it is generally known that such fermentation usually occurs under an anaerobic environment”, and thus the reference “does not inherently disclose a fermentation step while supplying oxygen as presently claimed.” This is not deemed persuasive for the reasons of record.

As previously stated, although not directly disclosed in the English-language abstract, the process would inherently incorporate a step of “supplying oxygen”, including such steps as stirring or utilizing an open container, as the yeast would necessarily ferment the soybeans under aerobic conditions. Note that the instant specification discloses at page 4, lines 3-5, that “suitable yeast includes any yeast belonging to *Saccharomyces*, such as beer yeast, wine yeast, sake yeast, or baker's yeast”. Such yeast (a) produce alcohol by fermenting sugars and starches, and (b) ferment aerobically, as well. Thus, applicants' statements that “it is generally known that such fermentation usually occurs under an anaerobic environment”, are not well supported. Further, applicants' claims do not specify a means by which oxygen is “supplied.” Given this, alternatively, the inclusion of a step to agitate the fermenting mixture in order to supply oxygen to the living yeast organisms, would have been obvious to one of ordinary skill in

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the art, based upon the teachings of the reference, as well as the knowledge of the state of the art at the time the invention was made, in order to facilitate the fermentation, and maintain the viability of the yeast.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kakeko (JP 57-125669). The reference and rejection are taken as cited in a previous Office action.

Applicant's arguments filed December 13, 2002, have been fully considered but they are not persuasive. At page 8 of the response, applicants state that “it is generally known that such fermentation usually occurs under an anaerobic environment”, and thus the reference “does not inherently disclose a fermentation step while supplying oxygen as presently claimed.” This is not deemed persuasive for the reasons of record.

As previously stated, although not directly disclosed in the English-language abstract, the process would inherently incorporate a step of “supplying oxygen”, including such steps as stirring or utilizing an open container, as the yeast would necessarily ferment the soybeans under aerobic conditions. Note that the instant specification discloses at page 4, lines 3-5, that “suitable yeast includes any yeast belonging to *Saccharomyces*, such as beer yeast, wine yeast, sake yeast, or baker's yeast”. Such yeast (a) produce alcohol by fermenting sugars and starches, and (b) ferment aerobically, as well. Thus, applicants' statements that “it is generally known that such fermentation usually occurs under an anaerobic environment”, are not well supported. Further, applicants' claims do not specify a means by which oxygen is “supplied.” Given this, alternatively, the inclusion of a step to agitate the fermenting mixture in order to supply oxygen to the living yeast organisms, would have been obvious to one of ordinary skill in the art, based upon the teachings of the reference, as well as the knowledge of the state of the art at the time the invention was made, in order to facilitate the fermentation, and maintain the viability of the yeast.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 (or those currently pending) of copending Application No. 09/929,064. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compositions produced by the same method, regardless of the preamble label of intended use of the composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9565 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



KEITH HENDRICKS
PRIMARY EXAMINER